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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/532,820	04/26/2005	Pierre-Paul Jodoin	8103-7us GH/ik	9401
20988	7590	07/28/2009		
OGILVY RENAULT LLP 1, Place Ville Marie SUITE 2500 MONTREAL, QC H3B 1R1 CANADA			EXAMINER EASWARAN, DAVID S	
			ART UNIT 3689	PAPER NUMBER
			MAIL DATE 07/28/2009	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/532,820	Applicant(s) JODOIN, PIERRE-PAUL	
	Examiner DAVID S. EASWARAN	Art Unit 3689	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 2 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 April 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 5-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 5-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 April 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Claims

1. This action is in reply to the amendment filed on 4/29/2009.
2. Claims 1 and 13 have been amended.
3. Claims 2 – 4 have been canceled.
4. Claims 1 and 5 – 13 are currently pending and have been examined.

Response to Amendment

5. The 112 2nd rejection of claim 3 has been withdrawn due to cancellation of claim 3.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claim states, in part, identifying used vehicles from new first owner vehicles and imputing any physical damage of said used vehicle into said databank. This implies that the used vehicles are identified from the set of "new first owner vehicles" when in actuality it appears applicant's intent is merely to distinguish the set of used vehicles from the set of new vehicles. As such, usage

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of the word "identifying" here is indefinite as it suggests a meaning other than applicant's intent. The examiner will assume that this limitations means the invention merely distinguishes when a vehicle is a used vehicle, and will then enter damage information into the database only for used vehicles. To overcome this rejection, applicant must clarify the terminology to eliminate this ambiguity.

Further, the claim recites using a particular code to designate the origin of vehicles. While previously unclear about what code applicant intended to use, the examiner now understands after amendment that applicant intended to reference the International Air Transport Association code. Referencing this code by name, however, is improper because the code can change over time. As such, when included in the claim language, the scope of the claim becomes indefinite and subject to change whenever the code itself is changed. For the purpose of compact prosecution, the examiner will interpret this limitation to refer to a code that identifies a country of origin. To overcome this rejection, applicant must define the code by describing specifics of the code, not by describing the owner or trade name of the code (in this sense, such usage is similar to a problem with include a trademarked item in a claim).

Claim Rejections - 35 USC § 101

8. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

9. Claims 1 and 5 – 13 are rejected under 35 U.S.C. 101. Based on Supreme Court precedent and recent Federal Circuit decisions, the Office's guidance to an examiner is that a § 101 process must (1) be tied to a particular machine or apparatus or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876).

To qualify as a § 101 statutory process, the claim should recite the particular machine or apparatus to which it is tied, for example by identifying the machine or apparatus that accomplishes the method steps, or positively reciting the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

There are two corollaries to the machine-or-transformation test. First, a mere field-of-use limitation is generally insufficient to render an otherwise ineligible method claim patent-eligible. This means the machine or transformation must impose meaningful limits on the method claim's scope to pass the test. Second, insignificant extra-solution activity will not transform an unpatentable principle into a patentable process. This means reciting a specific machine or a particular transformation of a specific article in an insignificant step, such as data gathering or outputting, is not sufficient to pass the test.

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Here, applicant's method steps fail the first prong of the new test because no sufficient tie to a particular machine exists. Applicant contends that there is a tie to a communication network, but this tie constitutes mere insignificant extra-resolution activity, in that the communication network only facilitates data gathering and outputting.

Further, applicant's method steps fail the second prong of the test because no underlying subject matter is transformed.

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Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

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4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
12. Claims 1 – 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rose, Jr. (US 5,521,815, hereinafter Rose) in view of Hall et al. (US 6,076,859, hereinafter Hall), Barr (*How to check your car's 'nationality'*, hereinafter Barr) and Dumford (*Identification systems deter car thieves; [Final Edition]*, The Gazette, Montreal, Quebec (Sept. 30, 1989), hereinafter Dumford) and further in view of Jack (US 4,987,287, hereinafter Jack).

Claim 1:

Rose discloses the following:

- *i) communication means establishing a service network including a service center having a databank for data processing and storage, and at least one service station providing anti-theft marking service to clients* (See at least Rose column 5, lines 14 – 19);
- *iii) verifying and collecting information on said markings* (See at least Rose column 14, lines 22 – 28);
- *iv) sending the collected information by computer means from the service station to the databank of the service center through a computer link* (See at least Rose column 5, lines 36 – 38);
- *v) a central computer at the service center for processing and storing the received information in said data bank* (See at least

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Rose column 5, lines 41 – 50, showing the database taking the information, processing it to create assign new title and registration information, and storing the data.);

- *vii) issuing a temporary certificate corresponding with the vehicle, to the client and an insurance company (See at least Rose column 16, lines 21 – 25, showing certificate creation and distribution to the client. Further, see Rose column 16, lines 4 – 13, showing a receipt corresponding to the vehicle being sent to an insurer);*
- *viii) identifying used vehicles from new first owner vehicles and imputing any physical damage of said used vehicle into said databank (See at least Rose column 16, lines 35 - 50, showing that for salvage vehicles, information regarding the state of the vehicle is input into the database.);*
- *ix) storing for further reference said temporary certificate with said service network (See at least Rose column 16, lines 16 – 17, stating that “[t]he information may be stored at the external data bases.”);*
- *xi) issuing an official certificate to said clients by said service network and wherein limited access is provided by link means to provide access to said data bank by said police and national custom department only (See at least Rose column 16, lines 21 – 25).*

Rose does not specifically disclose the following:

- *ii) means for effecting permanent engraved visible markings of an alphanumerical code at said service station, and verifying and collecting information on said markings, said markings being effected on a plurality of parts of a vehicle, said marking containing identification information of a client owning the vehicle and wherein said alphanumerical code used the International Air Transport Association (IATA) codes to identify a country of origin of said vehicle which allows cross-referencing with the vehicle identification number thereof, and at least one part of the vehicle having a visible logo identifying the anti-theft service;*
- *vi) linking the databank of the service network by network means to the at least one service station, the insurance company, a police department and the national customs department;*
- *x) processing collected information associated with said alphanumerical codes and transmitting same to said police department and customs department for verification and recording.*

Hall, however, does disclose these limitations.

Regarding limitation “ii” above, Hall discloses effecting permanent markings of an alphanumerical code at the service station and on a plurality of parts (See at least Hall, column 7, lines 31 – 35, showing the

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unique alphanumeric code. Further see Hall, column 7, lines 55 – 62, showing the codes being placed on numerous parts of the car.).

Rose and Hall do not specifically disclose using a code that comprises a country of origin. However, Barr does disclose a code that performs such a function (See Barr stating that “To check your car’s country of origin, refer to the Vehicle Identification Number. The first digit is the key: 1 or 4 means U.S.A., 2 is Canada, 3 is Mexico, 6 Australia...”). It would have been obvious for one of ordinary skill in the art at the time of the invention to use region-specific identifying codes, such as the code used in VIN numbers, with the barcode functionality of Hall, because such a combination would further “[increase] the likelihood that equipment designated for use in particular areas or regions will not be removed therefrom.” (See Hall, column 8, lines 51 – 53).

This embodiment of Hall does not specifically disclose “engraved visible markings.” However, Jack does contemplate a means for engraving visible markings (See at least Jack column 2, lines 27 – 49, showing an engraving procedure). It would have been obvious for one of ordinary skill in the art at the time of the invention to provide an engraving procedure as described by Jack in conjunction with the combination as disclosed above because it would constitute the simple substitution of one element (etching markings) for another (ultraviolet markings of the combination) to produce a predictable result (engraved visible markings).

Further, Dumford discloses that at least one part of the vehicle has a visible logo identifying the anti-theft service (See at least Dumford, stating that “[s]ome experts suggested that logos are in themselves a deterrent (One logo, from Secure-A-Car, glows in the dark.).”).

It would have been obvious for one of ordinary skill in the art at the time of the invention to combine the Rose-Hall combination with the logo display idea disclosed in Dumford because “[t]hieves are likely to bypass a car that sports any anti-theft logo” (Dumford).

Regarding limitation “vii” above, Rose discloses linking the service stations and the service network (See at least Rose column 5, lines 13 – 16), but does not disclose a connection to a local or national law enforcement body. Hall does disclose such a connection (See at least Hall column 8, lines 9 – 14).

Regarding limitation “x” above, Hall further discloses transmitting the processed information to the local and national authorities (See at least Hall column 9, lines 13 – 16).

It would have been obvious for one of ordinary skill in the art at the time of the invention to combine the anti-theft registration database of Rose with the car-part labeling system of Hall to “provide a method for marking personal property, and more particularly a method for marking personal property having a multiplicity of individually-valuable component

parts, for inventory-tracking and anti-theft purposes” (Hall, column 3, lines 6 – 10).

Claim 5:

The rejection of claim 1 above is incorporated herein. The Rose-Hall combination does not specifically disclose *installing the markings, including the intensive marking alphanumerical code and the visible logo, on the vehicle at the service station when the vehicle does not have the markings.*

However, Dumford does disclose that installation of the markings has been done at service stations (See at least Dumford, stating that “[a]t least two other comprehensive anti-theft marking systems are sold through Montreal car dealers.”) and that visible logos are standard fare for these services (See at least Dumford, stating that “[s]ome experts suggested that logos are in themselves a deterrent (One logo, from Secure-A-Car, glows in the dark.).”).

It would have been obvious for one of ordinary skill in the art at the time of the invention to combine the Rose-Hall combination with the installation specifics disclosed in Dumford because you can’t “expect the markings produced by an inexpensive do-it-yourself kit to match the effectiveness of professional engraving” and “[t]hieves are likely to bypass a car that sports any anti-theft logo” (Dumford).

Claim 6:

The rejection of claim 5 above is incorporated herein. Rose further discloses *A method as claimed in claim 5 further comprising a step of communicating with the service center to ensure that the intensive marking alphanumerical code provided to the vehicle does not match any existing intensive marking alphanumerical code stored in the databank* (See at least Rose column 8, lines 48 – 62).

Claim 7:

The rejection of claim 7 above is incorporated herein. Dumford further discloses *A method as claimed in claim 5 further comprising steps of installing the markings-on motor parts and installing the markings on external parts of the vehicle* (See at least Dumford, stating that “[t]he Sherlock Antitheft Marking...uses a sandblasting technique to engrave 50 parts of a car. Not just windows, but wheels, transmission and major engine parts.”).

It would have been obvious for one of ordinary skill in the art at the time of the invention to mark valuable car parts with the Rose-Hall combination because after such marking, these “components that are sold through car-theft rings – are indelibly identified” (Dumford). With such

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granular identification, the parts of marked cars could not be as easily resold, and therefore theft of marked cars would be reduced.

Claim 8:

The rejection of claim 7 above is incorporated herein. Dumford further discloses *not less than 50 parts of the vehicle are provided with the markings* (See at least Dumford, stating that “In addition to identifying about 50 parts, the comprehensive systems include computerized records.”).

It would have been obvious for one of ordinary skill in the art at the time of the invention to mark at least 50 parts with the Rose-Hall combination because “comprehensive systems that mark a large number of parts...work best” (Dumford).

Claim 9:

The rejection of claim 1 above is incorporated herein. Rose further discloses *sending a request for a temporary certificate from the service station to the service center when the vehicle already has the intensive marking alphanumerical code and the logo thereon* (See at least Rose column 11, lines 21 – 35, showing the re-registration process, which must be done annually in many states. Inherently, this re-registration process

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will only be performed after the vehicle has already been marked by the system.).

Claim 10:

The rejection of claim 9 above is incorporated herein. Rose further discloses *verifying the intensive marking alphanumerical code and logo on the individual motor parts and external parts of the vehicle upon the receipt of the temporary certificate from the service center* (See at least Rose column 11, lines 32 – 34).

Claim 11:

The rejection of claim 10 above is incorporated herein. Rose does not specifically disclose *adding the intensive marking alphanumerical code to a number of selected un-marked parts of the vehicle*.

Hall does disclose adding the markings to previous unmarked parts, however (See at least Hall column 7, lines 55 – 62,).

It would have been obvious for one of ordinary skill in the art at the time of the invention to combine the anti-theft method with the car-part labeling system of Hall to “provide a method for marking personal property, and more particularly a method for marking personal property having a multiplicity of individually-valuable component parts, for inventory-tracking and anti-theft purposes” (Hall, column 3, lines 6 – 10).

Claim 12:

The rejection of claim 10 above is incorporated herein. The Rose-Hall combination does not specifically disclose *adding the logo to a number of selected un-marked parts of the vehicle*.

Dumford does disclose using logos in addition to just markings (See at least Dumford, stating that "[t]hieves are likely to bypass a car that sports any anti-theft logo"). Therefore, it would have been obvious for one of ordinary skill in the art at the time of the invention to use logos with the anti-theft marking system because "experts suggested that logos are in themselves a deterrent" (Dumford).

Claim 13:

The rejection of claim 1 above is incorporated herein. Rose does not specifically disclose *obtaining signatures of the client and an agent of the service station on the certificate upon the completion of the verification and collection of the information and the inspection of the existing damages of the vehicle*.

However, Rose does disclose verification and collection of the information regarding damages to a vehicle and further contemplates adding security to the process by employing multiple parties, including the client, the title insurance company and the DMV (See at least Rose

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column 10, lines 59 – 67). It is likely that such a process would involve the signatures of the parties as an essential step, despite the reference not specifically mentioning such an element.

Regardless, it would have been obvious for one of ordinary skill in the art at the time of the invention to add the additional security measure of requiring the signatures of the parties to the inspection and verification process to be entered on the certificate, because it would add an additional check against potential fraud on the part of any party, and provide more reliability to the method as a whole.

Response to Arguments

13. Applicant's arguments filed 4/29/2009 have been fully considered but they are not persuasive. Each argument is discussed in turn below.
14. Applicant first argues that Hall teaches the use of labels, which are easily removable, not permanent markings. However, Hall teaches the affixation of permanent markings as disclosed in the prior office action (See at least column 7, lines 55 – 62, showing affixation of labels to the vehicle parts. However, see the very next sentence, which states that “[i]f the label is inadvertently or intentionally removed, the property and its owner can still be identified by exposing the surface where the label once resided to ultraviolet light, whereupon the LW-visible material reveals itself, outlining the PIN on the painted surface previously located beneath the apertures in the label, an area bereft of UV-visible

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material due to the prior absence of any impregnated label material thereover.”)

Further, if applicant wishes to draw a distinction from the prior art based upon the permanence of the marking of the vehicle parts, applicant must first define the term “permanent” such that its scope can be properly determined.

15. Applicant next argues that the reference found in Hall column 2, lines 26 – 42 shows etching that is not visible to the human eye. However, this fact is irrelevant to the claims in question; while the specification discusses the visibility of the markings, the claims do not recite that the markings must be visible and therefore if visibility of the markings is intended to serve as a distinguishing feature over the prior art, the feature should be incorporated into the claim language.
16. Applicant further contends that Hall “is not concerned with a method having specific discrete steps involving the permanent marking and the communication of information between elements of a network linking different entities and providing access to information and restricted information in the system.” The examiner believes that applicant intends to deny that the citations to Hall concerning amended claim 1 limitations viii, ix and xi teach the relevant limitations. However, mere allegation is not sufficient to overcome a prima facie case of obviousness. As such, these arguments are unpersuasive.
17. Finally, applicant contends that Dumford does not disclose the security network as defined by claim 1. The examiner has not set forth Dumford in a rejection of claim 1; therefore, this argument is moot.

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18. The following prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Department of Motor Vehicles (*VIN Information*), disclosing the ideas of permanently marking car parts with an alphanumeric code, the code in part recognizing the specific car as well as the country of origin.

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Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to **David Easwaran** whose telephone number is **571-270-5480**. The Examiner can normally be reached on Monday-Friday, 9:00am-5:30pm. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, **JANICE A. MOONEYHAM**, can be reached at **571-272-6805**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal/pair>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866.217.9197** (toll-free).

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/DAVID S EASWARAN/

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